

REMARKS

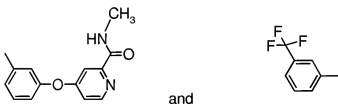
Amendments

The claims are amended to use language in accordance with conventional U.S. practice, to correct errors in dependency, grammar and punctuation, and to delete superfluous language. In addition, claims 11 and 12 are converted into method claims. See, e.g., page 9, lines 5-12. Claims 16-18, 29 and 32 are cancelled. Use claims 19-28 are converted into method claims. Method claims 30-31 are amended to be dependent on claim 19, rather than cancelled claim 29. Claims 34 and 35 are amended to be in independent form.

New claims 36-47 are directed to further aspects of applicants' invention and are supported throughout the disclosure. See, e.g., page 40, lines 1-9, page 42, line 21-page 43, line 8, page 44, lines 6-16, page 47, line 8-page 50, line 10, page 51, lines 9-11, and page 51, line 20-page 52, line 10.

Election

In response to the Lack of Unity Objection/Restriction, applicants hereby elect Group I, wherein L' is pyridine. Claims 1-10, 13, 14 and 36-47 read on the elected invention. As for the further election of a single disclosed species, applicants hereby elect compound 44 as shown in the Table at page 68. In this compound, D of formula I is -CO-NH-NH-CO-, and A and B are respectively,



Within the claims of the elected group, claims 1-6, 8-10, 13, 14, and 36-47 read on the elected species. The Lack of Unity Objection/Restriction is, however, respectfully traversed.

Firstly, it is noted that the three groups identified by the Examiner at page 3 of the Office Action do not encompass all of the compounds within the literal scope of applicants' formula I. For example, the three groups do not include compounds wherein B is an indolyl

group and L' is a phenyl, as well as many other compounds of applicants' Formulas I and II. Clarification is required.

It is noted that the instant application is the US national phase of a PCT application and, thus, PCT Rule 13.1 governs with regards to unity of invention (not Chapter 800 of the MPEP). In the Lack of Unity Objection, the Examiner argues that applicants' Markush compound claims are directed to at least three groups depending on the definitions of B and L'.

In support of the Lack of Unity Objection as to these Markush claims, the Examiner refers to "Markush Practice" as described in Annex B of the PCT rules. It should be noted that Annex B has been replaced by Chapter 10 of the PCT International Search and Preliminary Examination Guidelines (ISPE) enacted March 25, 2004. However, the guidelines are essentially the same as Annex B.

Referring to Annex B, Part 1(f) (see ISPE section 10.17), the Examiner argues that if one of the Markush alternatives is not novel over the prior art, then unity of invention shall be reconsidered by the Examiner. The Examiner then asserts that the compound (1,1'-biphenyl)-4-carboxylic acid, 2-(1,1'-biphenyl)-4-ylcarbonyl)hydroxide is in the prior art and is one of applicants' Markush alternatives. This, however, is incorrect. The compound does not fall within applicants' formula I as it does not exhibit a group L' which is substituted by at least one substituent selected from $-\text{SO}_2\text{R}_x$, $-\text{C}(\text{O})\text{R}_x$ and $-\text{C}(\text{NR}_y)\text{R}_z$. See applicants' claim 1. Thus, the Examiner has not set forth a basis for reconsidering unity of invention as to applicants' Markush compound claims.

With respect to process/method Groups IV and V, the Examiner argues that these groups are distinct from the compound claims, citing sections of MPEP chapter 800. As noted above, PCT Rule 13.1 governs with regards to unity of invention, not Chapter 800 of the MPEP.

Referring to ISPE 10.12 (see Annex B, Part 1(e)), Rule 13.1 permits combinations of claims directed to a given product, a process specially adapted to the manufacture of the product, and claims directed to the use of the product. The Lack of Unity Objection/Restriction presents no rationale as to why, in light of ISPE 10.12 (Annex B, Part 1(e)), the claims of Groups IV and V are said to lack unity with the compound claims under Rule 13.1.

In view of the above remarks, withdrawal of the Lack of Unity Objection/Restriction is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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